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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,347	11/29/2001	Julia MacLachlan	1-15092	6062

1678 7590 07/18/2005

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EXAMINER	
ROSSI, JESSICA	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,347	MACLACHLAN, JULIA	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *5/11/05, Amendment*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 5/11/05. Claims 23-38 are pending.

2. The new matter rejection of claim 23 under 35 U.S.C. 112 1st paragraph, as set forth in paragraph 6 of the previous office action, regarding the present specification not having support for the hydrophobic coating being located on the exterior of the vehicle glazing has been withdrawn in light of Applicant's arguments presented in the 5th paragraph on p. 18 of the remarks in combination with that disclosed in the 2nd paragraph on p. 1 of the specification. It is noted that this rejection was not withdrawn based on the 132 Declaration filed on 9/29/04 nor Applicant's arguments regarding the Nakanishi '130 reference, which were presented in the 2nd paragraph on p. 10 of the remarks.

3. The rejection of claims 23-24 and 26-33 under 35 U.S.C. 103(a) as being unpatentable over Curtze et al. in view of Yoshinori et al. and/or Van Der Putten et al., as set forth in paragraph 10 of the previous office action, has been withdrawn because the new matter rejection was withdrawn in paragraph 2 above.

4. The rejection of claims 23-24 and 26-33 under 35 U.S.C. 103(a) as being unpatentable over Hartig et al. in view of Yoshinori et al. and/or Van Der Putten et al. and also Curtze, as set forth in paragraph 14 of the previous office action, has been withdrawn in light of the 131 Declaration filed on 9/29/04 and Applicant's arguments pertaining to this Declaration, which were presented on p. 7-10 of the remarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26 and 34 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 26, it is unclear what Applicant means by "5-120 seconds or less" in line 4. It appears Applicant forgot to delete "or less" when amending the claim. It is suggested to do so in the next amendment.

Regarding claim 34, it is still unclear what Applicant is trying to claim since many of the limitations set forth in this claim were already set forth in claim 23. It is also unclear what Applicant means by "The method of claim 23 for selectively removing a hydrophobic coating" since claim 23 is directed to "A method of adhering an item to an area of a surface of a vehicle glazing" – note lack of antecedent basis exists for "The method of claim 23 for selectively removing a hydrophobic coating." Applicant is asked to clarify.

It is suggested to rewrite claim 34 to state, --The method of claim 23 further comprising: utilizing electro-mechanical means to provide relative movement between a source of the UV radiation and the hydrophobic coating to irradiate the area of the surface of the hydrophobic coating, thus selectively removing the hydrophobic coating.--

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 23-24 and 26-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinori et al. (JP 2001-146439; of record) in view of Curtze (US 4543283; of record) and

Teranishi et al. (US 5556667; of record), as set forth in paragraph 18 of the previous office action.

9. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinori, Curtze and Teranishi et al. as applied to claim 23 above, and further in view of Kizaki (US 5763892; of record), as set forth in paragraph 19 of the previous office action.

10. Claims 34-35 and 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinori, Curtze and Teranishi as applied to claim 23 above, and further in view of the collective teachings of Tweadey (5131967; of record) and Volkmann et al. (US 4931125; of record), as set forth in paragraph 20 of the previous office action.

11. Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinori, Curtze, Teranishi and the collective teachings of Tweadey and Volkmann as applied to claim 34 above, and further in view of Kizaki, as set forth in paragraph 21 of the previous office action.

12. Claims 23-24 and 26-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art referred to by Teranishi in view of Curtze and Yoshinori and/or Van Der Putten, as set forth in paragraph 22 of the previous office action.

13. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Teranishi, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of Kizaki, as set forth in paragraph 23 of the previous office action.

14. Claims 34-35 and 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Teranishi, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of the collective teachings of Tweadey and Volkmann, as set forth in paragraph 24 of the previous office action.

15. Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Teranishi, Curtze, Yoshinori and/or Van Der Putten and the collective teachings of Tweadey and Volkmann as applied to claim 34 above, and further in view of Kizaki, as set forth in paragraph 25 of the previous office action.

16. Claims 23-24 and 26-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (FR 2793889; of record) in view of Curtze and also in view of Yoshinori and/or Van Der Putten, as set forth in paragraph 26 of the previous office action.

17. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of Kizaki, as set forth in paragraph 27 of the previous office action.

18. Claims 34-35 and 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of the collective teachings of Tweadey and Volkmann, as set forth in paragraph 28 of the previous office action.

19. Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, Curtze, Yoshinori and/or Van Der Putten and the collective teachings of Tweadey and Volkmann as applied to claim 34 above, and further in view of Kizaki, as set forth in paragraph 29 of the previous office action.

20. Claims 23-24 and 26-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Franz et al. (US 4983459; of record) in view of Curtze and also in view of Yoshinori and/or Van Der Putten, as set forth in paragraph 30 of the previous office action.

21. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Franz, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of Kizaki, as set forth in paragraph 31 of the previous office action.

22. Claims 34-35 and 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Franz, Curtze and Yoshinori and/or Van Der Putten as applied to claim 23 above, and further in view of the collective teachings of Tweadey and Volkmann, as set forth in paragraph 32 of the previous office action.

23. Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Franz, Curtze, Yoshinori and/or Van Der Putten and the collective teachings of Tweadey and Volkmann as applied to claim 34 above, and further in view of Kizaki, as set forth in paragraph 33 of the previous office action.

Response to Arguments

24. Applicant's arguments filed 5/11/05 have been fully considered but they are not persuasive.

25. On page 15 of the remarks, Applicant argues that Hartig is not a reference applicable to the present application.

The examiner points out that this reference is no longer being applied as prior art against the present claims, as set forth in paragraph 4 above.

26. On pages 15 and 19-20 of the remarks, Applicant argues that Tweadey, as well as several other references cited by the examiner, refers to excimer lasers rather than excimer lamps. Applicant also argues that Tweadey teaches removing metal-based coatings and not hydrophobic coatings.

The examiner first points out that the present claims say nothing about excimer lamps and therefore this argument is not commensurate with the scope of the claimed invention; however, the examiner would like to point out that both Yoshinori (abstract; section [0027] – oral translation) and Van Der Putten (column 4, lines 43-47) teach using lamps to emit the UV radiation.

The examiner also points out that Tweadey is only relied upon to show it being known in the vehicle glazing art to use electro-mechanical means to provide relative movement between a source of UV radiation and a coating disposed on a glass substrate, where irradiation of the coating selectively removes the coating from areas of the glass.

27. On page 16 of the remarks, Applicant argues that Volkmann says nothing about removing a coating.

The examiner points out that Volkmann was only used to show it being known in the automotive art to use electro-mechanical means to provide relative movement between a source of electromagnetic radiation and a glass substrate.

28. On pages 17 and 19 of the remarks, Applicant argues that Curtze discloses a coating on the interior of the windshield.

The examiner points out that Curtze was never modified to have or used to show a hydrophobic coating on the exterior of a vehicle glazing. In all the rejections set forth above, Curtze was only used as a secondary reference to show it being known in the art to remove a hydrophobic, silane-based coating from an area of the surface of a vehicle glazing before adhering an item thereto.

29. On page 17 of the remarks, Applicant argues that Kizaki teaches using UV light to treat a surface but no mention is made of removing a previously, intentionally deposited coating.

The examiner points out that Kizaki was only used to show it being know in the art to use UV radiation having a wavelength of 172 nm to remove organic substances from the surface of a glass substrate – regardless of whether or not these substances were intentionally deposited.

30. On page 17 of the remarks, Applicant argues that Van Der Putten teaches removing a silane layer from a glass substrate using actinic radiation by an ArF excimer laser, oxygen plasma, or preferably a UV ozone treatment.

The examiner points out that the UV ozone treatment of Van Der Putten involves using a lamp to emit UV radiation (column 4, lines 43-47); however, it is once again pointed out that the present claims say nothing about how the UV radiation is emitted. Furthermore, Van Der Putten was only used to show it being know in the art to remove a hydrophobic silane-based coating from portions of a glass substrate by irradiating the same with UV light having a wavelength that falls within Applicant's claimed range (teaches silane-based coating on glass and removing with UV light having wavelength of about 185 nm; column 3, lines 35-39; column 4, lines 43-47 and 59-60; column 6, lines 14-27).

31. On page 17 of the remarks, Applicant argues that Anderson does not mention removing the coating or using UV light to do so.

The examiner invites Applicant to reread the 103 rejection set forth in paragraph 16 above and paragraph 26 of the previous office action.

32. On page 17 of the arguments, Applicant argues that the portion of the coating not removed by the UV radiation is broken down to generate ozone which is utilized in a later film removal step, while ozone generation is not part of the method of the present invention.

The examiner would like Applicant to know that a translator has been consulted and Yoshinori says nothing about ozone generation and using such in a later film removal step. Regardless, this would not change the fact that Yoshinori teaches removing part of a hydrophobic coating from the surface of a vehicle glazing using UV radiation having a wavelength that falls within Applicant's claimed range, as set forth in paragraph 8 above and paragraph 18 of the previous office action.

33. On page 18 of the remarks, Applicant argues that Franz does not mention removing the coating or using UV light to do so.

The examiner invites Applicant to reread the 103 rejection set forth in paragraph 20 above and paragraph 30 of the previous office action.

34. On page 18 of the remarks, Applicant argues that Teranishi does not mention removing the coating or using UV light to do so.

The examiner invites Applicant to reread the 103 rejection set forth in paragraph 12 above and paragraph 22 of the previous office action.

35. On page 21 of the arguments, Applicant argues that none of the cited references alone or in combination properly teach the presently claimed limitations.

The examiner agrees that none of the references alone teach the claimed limitations and that is why no 102 rejections were presented in the previous or present office actions. Applicant also argues that none of the 103 rejections set forth in the previous office action are proper;

however, the examiner points out that Applicant has not presented any arguments as to why these combinations are improper. Instead, Applicant just argues each reference in a vacuum. Therefore, the examiner invites Applicant to reread the 103 rejections set forth in the previous office action and maintained in the present office action, which use prior art teachings to provide ample motivation for the modifications made in each rejection to render the claimed invention obvious.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
Primary Examiner
Art Unit 1733